

### **REMARKS**

Reconsideration of the rejections set forth in the Office Action mailed October 5, 2004, is respectfully requested. Claims 1 and 13 have been amended. Claims 1-20 remain pending. Support for the amendments can be found in the specification at, e.g., Figs. 11A and 11B and page 28, line 5 – page 29, line 2. Therefore, these amendments have been made without the addition of new matter.

#### **35 U.S.C. § 112**

Claims 1-16 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. In particular, the examiner questions the limitation of “a channel-less flow chamber having a partition” in claims 1 and 13. Applicants have amended claims 1 and 16 to specify that the partition that partially separates the first and second reaction areas is impermeable to a fluid.

#### **Art Rejections**

Claims 1, 2, 4-9, 13, 15, and 16 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Heller et al. (WO 96/07917), taken in view of Markx et al. (J. Biotechnol. 1996). Claim 3 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Heller et al. and Markx et al., and further in view of Betts et al. Claims 10-12 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Heller et al. and Markx et al., and further in view of Laas et al. Claim 14 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Heller et al. and Markx et al., and further in view of

Kambara et al.

Applicants respectfully assert that the cited references do not teach or suggest all of the limitations of the amended claims. The claims have been amended to specify that “*first reaction area and the second reaction area are partially separated by a partition that is impermeable to a fluid.*” Heller et al. does not teach or suggest a flow chamber having a first reaction area and a second reaction area that are “*partially separated by a partition that is impermeable to a fluid.*” As seen in Fig. 6 of Heller et al. (and accompanying description on page 18, line 14 – page 19, line 22), the crude DNA selector (68) and Restriction Fragment Selector (70) are not separated by such a partition. Therefore, applicants respectfully request withdrawal of the rejections and reconsideration of the claims as amended.

#### Double Patenting

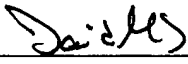
Claims 1, 2, 4-7, 9-13, and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 3-7 of U.S. Patent No. 6,280,590 in view of Heller et al. and Marx et al. Claims 8 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 3-7 of U.S. Patent No. 6,280,590 in view of Heller et al. and Marx et al. and further in view of claim 6 of U.S. Patent No. 6,071,394. Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 3-7 of U.S. Patent No. 6,280,590 in view of Heller et al. and Marx et al. and further in view of Kambara et al. Claims 17-20 were rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claim 8 of U.S. Patent

No. 6,280,590 in view of Heller et al. and Marx et al. and Heller et al. (U.S. Patent No. 5,605,662). Without conceding the propriety of the rejections, applicants file a terminal disclaimer herewith.

For all the foregoing reasons, Applicants assert the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicants' undersigned representative at (949) 737-2900. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-0639.

Respectfully submitted,  
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